

Application No.: 10/692,584
Response Dated: December 19, 2009
Office Action Dated: August 19, 2009

REMARKS

This is in response to the Office Action dated August 19, 2009, for which a three (3) month period for response was given. A Petition and fee for a one (1) month extension of time accompany this paper. The Commissioner is hereby authorized to charge the extension of time and any other necessary petition and/or claims fees to Deposit Account No. 50-0959, Attorney Docket No. 089498.0447.

Claims 11 and 15 through 19 are pending in the application upon entry of this amendment. Claims 12 through 14 and 20 have been cancelled, while claims 1 through 10 were previously canceled. Claim 11 has been amended for clarification purposes. Support for the amendments to claim 11 can be found, for example, in the specification at page 6, lines 17 through 32, and in the Examples. As such, no new matter has been added to claim 11. In view of the above, entry and consideration of the amended claims and the remarks which follow is believed due and is respectfully requested.

I. The Telephone Interview of December 18, 2009:

The undersigned attorney would like to thank Examiner Lee for participating in a telephone interview on December 18, 2009. During the interview the undersigned and Examiner Lee discussed the 35 U.S.C. § 112, first paragraph, rejections. Given this, the undersigned believes that the present Reply incorporates the agreement reached with Examiner Lee. If this is not the case, the undersigned hereby requests that Examiner Lee contact the undersigned to discuss the status of this patent application.

Furthermore, as was discussed with Examiner Lee, the undersigned reserves the right to file one or more continuation applications directed to the other types of polymer and the other types of nanoparticles that were originally disclosed in the present patent application as filed.

II. The 35 U.S.C. § 112, First Paragraph, Rejections:

Claims 11 through 20 have been rejected under 35 U.S.C. § 112, first paragraph, based on a lack of enablement with regard to the list of polymers and nanoparticles contained in the application as filed (see, e.g., previously pending claims 12 and 14).

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While not admitting that the enablement rejection is properly founded the undersigned has amended claim 11 to recite that the polymer of claim 11 is selected from polystyrene or polylactic acid (these are both specifically supported by Examples contained in the application as filed) and that the nanoparticles are selected from nanoclays or substituted Montmorillonite (again these nanoparticles are supported by Examples contained in the application as filed). As such, due to the compounds recited in claim 11 as currently amended it is believed that the 35 U.S.C. § 112, first paragraph, rejection of claims 11 through 20 has been rendered moot. Accordingly, withdrawal of this 35 U.S.C. § 112, first paragraph, rejection of claims 11 through 20 is believed due and is respectfully requested.

Claims 11 through 20 have been rejected under 35 U.S.C. § 112, first paragraph, as failing to comply with the written description requirement. Specifically, Examiner Lee states that the specification does not support the portion of claim 11 that states “wherein the steps of quenching the polymeric composition and the step of forming the film are interchangeable.”

As discussed on the telephone interview of December 18, 2009 the Examples as filed support the interchangeability of the quenching step and the film forming step. Although not the only examples of the different order of the quenching step and the film forming step Examiner Lee’s attention is directed to Examples 2 and 9 of the application as filed.

As such, due to the disclosure contained in the specification as filed, it is believed that the 35 U.S.C. § 112, first paragraph, rejection of claims 11 through 20 has been rendered moot. Accordingly, withdrawal of this 35 U.S.C. § 112, first paragraph, rejection of claims 11 through 20 is believed due and is respectfully requested.

III. The 35 U.S.C. § 102(a) and 35 U.S.C. § 103(a) Rejections:

Claim 20 has been rejected under 35 U.S.C. § 102(a) over Yamada et al. (JP 2002-363393). Additionally, claim 20 has been rejected under 35 U.S.C. § 103(a) over the Kobayashi et al (United States Patent No. 6,139,948) in view of Okabe et al. (United States Patent No. 4,725,472).

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However, due to the cancellation of claim 20 both the 35 U.S.C. § 102(a) rejection and the 35 U.S.C. § 103(a) rejection have been rendered moot. As such, withdrawal of both the 35 U.S.C. § 102(a) rejection and the 35 U.S.C. § 103(a) rejection is believed due and is respectfully requested.

IV. Conclusion:

For at least the foregoing reasons, the 35 U.S.C. § 112, first paragraph, rejections, the 35 U.S.C. § 102(a) rejection, and the 35 U.S.C. § 103(a) rejection are believed to be unfounded, and withdrawal thereof is believed due and is respectfully requested.

For at least the foregoing reasons, the present application is believed to be in condition for allowance, and a Notice of Allowance is respectfully requested.

Should the Examiner wish to discuss any of the foregoing in more detail, the undersigned attorney would welcome a telephone call.

Respectfully submitted,

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